

U.S. Application No.: 09/113,747  
Group Art Unit: 2611

Attorney Docket No.: 112592A

### **REMARKS**

Reconsideration and allowance are requested. The Examiner rejected pending claims 1 - 53. No claims are amended.

**A. Rejection of Claims 1 - 4, 6-7, 9-17, 19-20, 23-30, 33-39, 42-48 and 51-53 rejected under 35 U.S.C. §103(a)**

The Examiner rejected claims 1-4, 6-7, 9-17, 19-20, 23-30, 33-39, 42-48 and 51-53 as being unpatentable under Section 103(a) as being unpatentable over U.S.Pat. No. 5,928,330 to Goetz ("Goetz") in view of U.S.Pat. No. 5,794,018 to Vrvilo et al. ("Vrvilo et al.").

Applicants traverse this rejection and submit that there is insufficient motivation or suggestion to combine these references and even if combined, they would still not teach each claim limitation.

We first turn to claim 1. This claim recites an instruction to analyze, at the receiver, parameters associates with the quality of displayed data and to formulate at the receiver and based on the analysis, a media parameter suggestion for an encoder to alter the characteristics of the data to be sent to the receiver. The Examiner concedes that Goetz does not teach these limitations but that Vrvilo et al. "in the same field of network-based environment" does teach this limitation and that it would be obvious to modify Goetz's system with Vrvilo et al.'s teachings "of requesting the display of presentation data as the quality of displaying data is of concern."

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done.

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"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In the present case, the Examiner has failed to carry his burden of articulating why one of skill in the art would have been motivated to combine these references. In essence, the Examiner has stated that these references can be combined - they are "in the same field of network-based environment". However, there are differences that would lead one of skill in the art away from combining these references. Notably, the purpose of Goetz is to operate in a "client-server" context wherein the invention includes a mechanism for inferring network conditions from which the server may then stream units of multimedia information to the client at a particular streaming rate from the inferred network conditions. See Abstract. It is clear from the abstract and other places in Goetz such as FIGs. 10 and 11 that the server/client interaction relates to the Internet and packet-based protocols. See, e.g., col. 6, lines 41 - 68. Throughout the disclosure, Goetz discuss the packet structure and process of transmitting packets. This is important because in contrast to a server/client environment, Vrvilo et al. teach a conferencing environment in which the communication path is an ISDN network. See FIG. 1, FIG. 7, col. 1, lines 18 - col. 2, line 29. Where Vrvilo et al. introduce their invention as related to real-time audio and video conferencing in which the respective conferencing systems communicate via an integrated services digital network (ISDN), one of skill in the art would recognize the differences in the protocols and basic operational components between an ISDN connection and a packetized connection. Where the Internet

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does not always provide a real-time interaction in that packets can be lost or dropped and then resent, the ISDN provide a switch-based connection that is better suited for real-time communications. Thus, ISDN is preferable for live video conferencing and thus is the network of choice for Vrvilo et al. See Newton's Telecom Dictionary, ISDN entry. Vrvilo et al. also do not contemplate or suggest a client/server environment where they mention other possible transport mechanisms for their communication. They only mention ISDN, SW56 (a switch-based protocol) and LAN. Col. 7, lines 40 - 44. Because Vrvilo et al. are so focused on the video-conferencing environment, they fail to provide any of the requisite suggestion to combine their teachings with patents such as Goetz.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The Examiner asserts that it would be obvious to combine teachings from Vrvilo et al., such as from col. 38, line 62 to col. 40, line 65 related to multiple video formats and different resolutions. This would change the principle of operation of Goetz because in a client/server environment, display information is not utilized at each end like it is in video conferencing. In the portion of Vrvilo et al. cited by the Examiner, they teach that in a video conferencing context, there is a local display that receives an uncompressed signal and the remote display (the other part in the video conference) that is sent a compressed video stream. In col. 39, lines 1 - 15, they discuss how a video manager makes use of the uncompressed video stream to generate a local monitor display and that the video manage may select one of several formats for displaying that local information. Applicants traverse the Examiner's assertion that this teaching could be combined with Goetz. Remote display data and local display data are irrelevant in a client/server context where the server is sending data for display at the client but not necessarily the other way around.

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If the examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. 103, the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not. MPEP 2142.

Accordingly, Applicants submit that by a preponderance of the evidence, and because Goetz focuses on a client/server environment in a packet network such as the Internet, and wherein Vrvilo et al. teach a video conferencing invention utilizing an ISDN connection, one of skill in the art would not have sufficient motivation to combine these references. Applicants submit that one of skill in the art who is studying the Goetz references would not be motivated to seek for further technical assistance in Vrvilo et al. because he or she would instantly recognize that it teaches a conferencing environment that is ISDN based and thus differs from the technical protocols and issues relates to a client/server environment. Furthermore, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir.

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1991). MPEP 2143.01. In this case, the burden on the Examiner is to articulate why one of skill in the art would be motivated to combine these references and that showing must be more than simply stating that these patents are "in the same field". The overall suggestive power of each reference leads away from their combination by at least a preponderance of the evidence.

Accordingly, for this reason, Applicants submit that claim 1 is patentable.

In addition, even if these references are combined, the Examiner has yet to show in the combined teachings where the limitations of analyzing, at the receiver, parameters associated with the quality of displayed data and to formulating at the receiver and based on the analysis, a media parameter suggestion for an encoder to alter the characteristics of the data to be sent to the receiver. None of the portions of Vrvilo et al. cited by the Examiner teaches these specific steps. While they teach some reference to modifying or selecting a display resolution or some other feature of a display, they simply fail to teach these steps. FIG. 34 merely outlines how a connection is established. Cols. 38 - 40 discuss different display formats but don't teach these particular limitations and Cols 42 - 43 also discuss selecting a particular video format and resolution but it is based on a desired level of quality, transmission bandwidth, processor performance, video resolution and video format. They simply do not mention these limitations in claim 1 related to analyzing, at the receiver, parameters associated with the quality of displayed data and to formulating at the receiver and based on the analysis, a media parameter suggestion for an encoder to alter the characteristics of the data to be sent to the receiver.

Accordingly, even if combined, these references fail to teach each limitation of claim 1 and this claim is now patentable and in condition for allowance.

Claims 2 - 4, 6 - 7, 9 - 17, 22 - 26 each depend from claim 1 and recite further limitations therefrom. Accordingly, Applicants submit that these claims are patentable as well.

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Claim 27 includes similar limitations to those discussed above relative to claim 1. Accordingly, method claim 27 and its dependent claims 28 - 30, 33 - 39 and 41 - 45 are patentable as well.

Claim 46 recites an apparatus that includes limitations similar to those set forth above for claim 1. Accordingly, claim 46 and dependent claims 47 - 48 and 50 - 53 are patentable as well.

**C. Rejection of Claims 5 and 18 under 35 U.S.C. § 103(a)**

The Examiner rejects claims 5 and 18 as being unpatentable over Goetz in view of Vrvilo et al. and U.S. Pat. No. 5,014,125 to Pocock et al. ("Pocock et al."). Applicants traverse this rejection and submit that inasmuch as, based on the arguments above, the two primary references of Goetz and Vrvilo et al. should not be combined, that these two claims are therefore patentable.

However, an addition reason exists for the lack of motivation to combine these three references. As discussed above, Goetz is a client-based disclosure and Vrvilo et al. is a video conferencing application over ISDN. Pocock et al is also in contrast to both of these references where they teach a cable television system having a user terminal communicating with a distribution cable and a switched telephone network. Abstract, FIG. 1. One of skill in the art readily recognizes the differences in communication protocols between a server/client environment, an ISDN video conferencing environment and the cable TV interactive environment of Pocock et al. Each of these networks has different issues involved and one of skill in the art would not be motivated to search for technological solution from one environment to the next.

**C. Rejection of Claims 8, 21, 31, 40 and 49 under 35 U.S.C. § 103(a)**

The Examiner rejects claims 8, 21, 31, 40 and 49 over Goetz in view of Vrvilo, et al. as described above and as being unpatentable over Goetz in view of Vrvilo, et al. as described above and U.S. Pat. No. 5,673,401 to Volk ("Volk"). Applicants traverse this rejection.

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As discussed above, Applicants submit that by a preponderance of the evidence, one of skill in the art would not have sufficient motivation to combine Vrvilo et al. with Goetz. Therefore, for this reason alone, Applicants submit that claims 8, 21, 31, 40 and 49 are patentable.

However, an addition reason exists for the lack of motivation to combine these three references. As discussed above, Goetz is a client/server based disclosure and Vrvilo et al. is a video conferencing application over ISDN. In contrast to both of these is Volk who addresses an issue dealing with cable television systems having a "set top box" in which a user can use a remote control (FIG. 4) to communicate with the set top box and have an interactive television experience. The cable TV system that is interactive includes the ability to have "upstream" communications from the user back to the service provider for taking action. See columns 1, 2. Simply put, one of skill in the art readily recognizes the differences in communication protocols between a server/client environment, an ISDN video conferencing environment and a cable TV interactive environment. Each of these networks has different issues involved and one of skill in the art would not be motivated to search for technological solution from one environment to the next.

### CONCLUSION

Having addressed the rejection of claims 1 -53, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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